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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,344	08/05/2003	Ronald P. Laliberty	043596.091	6750

25461 7590 09/06/2006
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EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,344

Applicant(s)

LALIBERTY ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18 and 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8, 10, 11, 13-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (5,704,858) in view of Talarico et al. (5,951,420) and Walker et al. (5,647,590). Regarding claim 1, Yang discloses a game ball construction comprising a plurality of layers of foamed material. Note column 1, line 46 through column 2, line 12 teaching a core (11) having a first hardness, a first mantle layer (14) having a second hardness, a second mantle layer (13) having a third hardness and a cover (2). The first hardness has the greatest hardness, the third hardness has the second greatest hardness and the second hardness is the softest material. Regarding the limitation for the core to comprise no more than two mantle layers, it would have been obvious to one of ordinary skill in the art to eliminate one of the layers (12) of Yang in order to produce a harder ball. Note column 2, lines 16-19 stating that the first layer (12) acts as a cushioning layer for absorbing vibrations and shocks. It would have been obvious to one of ordinary skill in the art to eliminate the layer (12) as such would constitute a mere elimination of a part and its associated function. *In re Karlson*, 136 USPQ 184; *In re Wilson et al.*, 153 USPQ 740.

Talarico discloses a game ball comprising a central core (2), a first mantle (4) and a cover (8). Note column 2, lines 1-18 stating that the core and mantle are open and closed urethane compositions formed by mixing a polyol with isocyanate. Talarico also states that the different layers possess different hardnesses dependent upon the proportions of polyol and isocyanate used. It would have been obvious to one of ordinary skill in the art to form the layers of Yang

from a polyurethane material as taught by Talarico in order to take advantage of that material's well known physical characteristics.

However, the combination of Yang in view of Talarico lacks the teaching for the polyurethane core to have a coefficient of restitution as recited. Walker discloses that it is well known in the art of game balls to provide a central core of polyurethane foam having a coefficient of restitution at 88 feet/second of less than 0.45. It would have been obvious to one of ordinary skill in the art to form the central core of Yang from a polyurethane foam as taught by Walker in order to create a ball of a particular hardness. Further, it would have been obvious to one of ordinary skill in the art to modify the coefficient of restitution of the central core to the recited limits as the applicant has not shown the criticality for the recited limits and it appears the limits taught by Walker would accomplish similar purposes.

Regarding the limitation for the ball to be a competitive game ball, the balls of Yang, Talarico and Walker are obviously capable of being used in competitive game play. Further, the limitation occurs in the preamble of the claim.

Regarding claims 2, 4, 5, 7, 8 and 14-16, the combination of Yang in view of Talarico and Walker teach for the foamed material to be a urethane.

Regarding claim 3, Walker discloses a polyurethane foam formed from a mixture of 100 parts polyol and 33-40 parts isocyanate. It is noted that the applicant has not demonstrated the criticality for the recited ratio by a showing of a new and unexpected result obtained therefrom. It would have been obvious to one of ordinary skill in the art to form the core of Yang using a polyurethane formed from 100 parts polyol and greater than 40 parts isocyanate in order to provide a core of a particular hardness.

Regarding claim 6, it would have been obvious to one of ordinary skill in the art to eliminate the layer (14) instead of the layer (12) of Yang in order to produce a harder ball that is still capable of absorbing vibrations and shock. Note column 2, lines 18 and 19 of Yang stating that the layer (12) absorbs vibration and shocks.

Regarding claims 10, 11 and 18, it would have been obvious to one of ordinary skill in the art to form the ball of Yang as modified by Talarico and Walker with the recited dimensions for the thickness of the layers as the applicant has failed to demonstrate the criticality for the claimed dimensions by a new and unexpected result and it appears that the dimensions taught by Yang as modified by Talarico and Walker would accomplish similar purposes.

Regarding claims 13, 20 and 21, Walker teaches a compression of 0.06-0.07 inches when subjected to a force of 10 lbs. The particular limitation for the compression being between 325 and 475 pounds or more particularly 350 and 550 pounds is considered to be obvious given the teachings of Walker. It would have been obvious to one of ordinary skill in the art to form the ball of Yang as modified by Talarico and Walker with a compression between 350 and 550 pounds in order to produce a ball having a particular hardness.

3. Claims 9, 17 and 22-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (5,704,858) in view of Talarico et al. (5,951,420), Walker et al. (5,647,590) and Morgan (4,772,019). Regarding claims 9, 17 and 22, Yang lacks the teaching for the recited weights and dimensions as recited in claims 9 and 17. Further, Yang lacks the teaching for the ball to be a softball.

Morgan reveals that it is well known in the art to apply inventive concepts to both baseballs and softballs. More particularly, Morgan states that it is known in the art to alter the

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structure of both baseballs and softballs in order to provide a ball that is not quite as hard and poses fewer safety problems. It would have been obvious to one of ordinary skill in the art to form the ball of Yang as a softball with appropriate size and weight in order to provide a safer softball with little or no risk of injury to players.

Regarding claims 23, 26, 27, 33 and 34, Yang discloses a core comprising a central core (11) comprising a first hardness, a first outer core layer (12) having a second hardness less than the first hardness, a second outer core layer (13) having a hardness greater than the second hardness and a cover (2) surrounding the core.

Regarding claims 24 and 25, note the rejections of claims 2 and 4.

Regarding claims 28 and 35, it would have been obvious to one of ordinary skill in the art to eliminate the first outer core layer (12) from the ball of Yang in order to change the hardness of the ball. By eliminating the layer (12), the ball of Yang presents a central core (11) comprising a first hardness, a first outer core layer (13) having a second hardness less than the first hardness, a second outer core layer (14) having a hardness less than the second hardness and a cover (2) surrounding the core.

Regarding claims 29-31, the recited compressions for the ball have been considered to be obvious given the teachings of Yang in view of Talarico, Walker and Morgan. It would have been obvious to one of ordinary skill in the art to form a softball with the recited compression in order to create a ball with a particular hardness.

Regarding claims 32 and 33, note the rejection of claims 2 and 4.

Response to Arguments

4. Applicant's arguments filed August 9, 2006 have been fully considered but they are not persuasive. The applicant argues that there is no suggestion in the art to modify the reference to Yang as set forth by the examiner. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation lies in the knowledge generally available to one of ordinary skill in the art. Here, the elimination of the layer (12) amounts to a mere elimination of parts and its associated function. The applicant argues that the elimination of the layer would render the ball unsatisfactory for its intended purpose. However, while removal of the layer might produce a harder baseball, this modification would be far from destroying the intent of the invention. Yang still includes a cushioning layer (14) that prevents "the player from being hurt by the baseball" (column 2, lines 13-15). The objective of the invention of Yang is to produce a safety baseball having a soft outer portion for preventing the children from being hurt. The elimination of the layer (12) is seen as producing a harder baseball, however, the objective is still maintained as Yang still provides a cushioning layer (14) that creates a soft outer portion for preventing the children from being hurt.

Regarding the citations to *Karlson* and *Wilson and Benning*, it is noted that in both cases the elimination of parts was deemed to be obvious as long as the modification did not destroy the

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reference. As stated above, the elimination of the layer (12) of Yang would produce a harder baseball, however, it would not destroy the intent of the invention. As cited above, the baseball still includes a cushioning layer (14) that prevents players from being hurt. Thus, the modified baseball is still capable of accomplishing the objective of the invention and the removal of the layer (12) is considered to be obvious to one having ordinary skill in the art.

While Yang provides two layers to provide the cushioning device, he also provides individual purposes for the two cushioning layers (12, 14). Thus, the removal of one or the other cushioning layer would have been obvious to one of ordinary skill in the art in order to create a harder baseball that still retains the purpose of the remaining cushioning layer.

Regarding the rejection of claim 6, the applicant argues that the elimination of layer (12) in the ball of Yang would not produce the layers and respective hardnesses as recited. The applicant is requested to note above where it is considered to be obvious to one of ordinary skill in the art to eliminate the layer (14) instead of the layer (12) in the ball of Yang. Yang particularly teaches that the layer (12) absorbs vibration and shock. It would have been obvious to one of ordinary skill in the art to eliminate the layer (14) in order to produce a harder baseball that is still capable of absorbing vibration and shock.

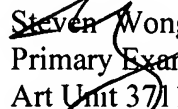
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
September 1, 2006